

REMARKS

The Applicant has now had an opportunity to carefully consider the comments set forth in the Office Action mailed November 7, 2007. Acknowledgement of allowable subject matter in **claims 20** and **21** is noted with appreciation. Nevertheless, the rejections of **claims 1-3, 7, 9, 11-15** and **18-19** are respectfully traversed.

The Office Action

In the Office Action mailed February 8, 2007:

claims 20 and **21** were allowed;

a response to arguments presented in Applicant's Amendment E was provided;

claims 1, 3, 6, 7, 12-15 and **17-19** were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,501,556 to Nishii ("Nishii");

claims 2 and **11** were rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of Japanese Published Application No. JP 07-307827 by Nakajima Toru ("Toru"); and

claims 9 and **19** were rejected under 35 U.S.C. 103(a) as being unpatentable over Nishii in view of U.S. Patent No. 5, 550,614 to Motoyama ("Motoyama").

The Claims Have Been Amended to Include Subject Matter That Has Been Recognized to Be Allowable

Page 11 of the Office Action that was mailed February 8, 2007, indicates that **claim 20** is allowable because the prior art fails to disclose a printing system that automatically excludes unwanted non-blank pages of a job from a main job output stream comprising means for describing one or more characteristics of a non-blank page that is unwanted.

While the Applicant maintains the position presented in Applicant's Amendment E and previously filed papers, that the rejections presented in the present Office Action are based on impermissible hindsight reasoning and other clear errors of fact with regard to the disclosure of Nishii, Toru and Motoyama, in the interest of compact prosecution, it is submitted that independent **claims 1, 11, 12** and **13** have been amended to include subject matter that has been

recognized by the Examiner to be allowable.

For example, **claim 1** has been amended to recite *inter allia*: establishing a characteristic of a page indicative of an unwanted page, the established characteristic including a description or indication of one or more mark or image included on the unwanted page.

Claims 11 and 12 have been amended to recite *inter allia*: describing characteristics of the unwanted portions of the job, the described characteristics including a description of a mark included in the unwanted portions of the job.

Claim 13 has been amended to recite *inter allia*: a pattern detector operative to receive an arbitrary description of an unwanted portion of the main print job input image data including marking information associated with the unwanted portion.

Accordingly, for these reasons as well as those presented in Applicant's Amendment E and previously filed papers, independent **claims 1, 11, 12, 13 and 20**, as well as **claims 2-3**, which depend from **claim 1**; **claims 7 and 9**, which depend from **claim 12**; **claims 14, 15, 18 and 19**, which depend from **claim 13**; and **claim 21**, which depends from **claim 20** are allowable.

Comments on Reasons for Allowability

On pages 10 and 11 of the previous Office Action, which was mailed February 8, 2007, the Examiner provided reasons for the allowability of **claims 20 and 21**. This indication is noted with appreciation. However, while the Applicant agrees that the claims are allowable for at least the reasons indicated in that paper, the Applicant does not concede that the reasons identified by the Examiner are the only reasons. For example, the Applicant believes the claims are allowable for at least the reasons identified in Applicant's Amendment E and previously filed papers.

Telephone Interview

In the interests of advancing this application to issue, the Applicant respectfully requests that the Examiner telephone the undersigned to discuss the foregoing or any suggestions that the Examiner may have to place the case in condition for allowance.

CONCLUSION

Claims 1-3, 7, 9, 11-15, and 18-21 remain in the application. **Claims 1, 11, 12 and 13** have been amended. For at least the foregoing reasons, the application is in condition for allowance. Accordingly, an early indication thereof is respectfully requested.

☒ Remaining Claims, as delineated below:

| (1) FOR | (2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR | | (3) NUMBER EXTRA |
|-----------------------|---|--------|------------------|
| TOTAL CLAIMS | 14 | - 20 = | 0 |
| INDEPENDENT CLAIMS | 5 | - 5 = | 0 |

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account 24-0037.

Respectfully submitted,

FAY SHARPE LLP

1/16/08
Date


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| Express Mail Label No.: | Signature: <i>Mary Ann Temesvari</i> |
| Date: <i>January 16, 2008</i> | Name: Mary Ann Temesvari |

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